

REMARKS:

CITATION OF REFERENCES

The Applicant submits that, in a previous Office Action, the Examiner has based rejections to patents to U.S. Patent 6,498,870 to Wu et al. and U.S. Patent 6,523,961 to Ilkov. However, the Examiner has not cited either patent in a List of References Cited (Form PTO-892). The Applicant respectfully requests that the Examiner provide a new PTO-892 listing the omitted references.

CLAIM REJECTIONS

35 USC 112

10 The Examiner has rejected claim **15-45** and **56-61** under 35 U.S.C. 112, second paragraph as being indefinite. In rejecting the claim **15**, the Examiner states that the recitation “anti-stiction member that is interposable between the moveable member and the substrate” only indicates the possibility that the anti-stiction member being in-between the moveable member and the substrate. In response, the Applicant respectfully submits that the term “interposable”, as it appears in claim **15**, means more than a mere possibility. Specifically, the Encarta® World English Dictionary, North American Edition defines the root word “interpose” to mean “place between people or things” and the suffix “-able” to mean “capable of or fit for”. Consequently, “interposable” means that the anti-stiction member has a capability of being deliberately interposed between the moveable element and the substrate. As such, claims **15** and **29** and **50** 15 are neither vague nor indefinite and claims **15-45** and **50-61** define an invention suitable for 20 patent protection.

In rejecting claims **35** and **36** the Examiner argues that there is no antecedent basis for “the one or more flexible portion”. In response the Applicant has amended claims **35** and **36** to depend from claim **34**, which does recite this feature. With respect to claims **42** and **52**, the Examiner 25 argues that the parenthesis around the limitations makes the claim vague and indefinite. In response the Applicant has amended claims **42** and **52** to remove the parentheses and state explicitly that which was implied by the subject matter in the parentheses. The Applicant submits that the amendments to claims **35**, **36**, **42**, **52** merely make explicit that which was

implicit in the claims as filed. As such, these amendments do not narrow any limitation of claims 35, 36, 42, 52 within the meaning of the decision in *Festo Corp. v. Shoketsu Kogyo Kabushiki Co., Ltd.*, 234 F3d 558, 566, 56 U.S.P.Q.2d 1865 (Fed. Cir. 2000) 535 U.S. 722, 152 L. Ed. 2d 944, 122 S. Ct. 1831, (2002).

5 35 USC 102 Anderson

The Examiner has rejected claims 1, 11-17, 24, 26, 29-31, 38, 40-44, 50-55 under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 6,600,591 to Anderson et al. (hereinafter Anderson). In rejecting the claims, the Examiner states that Anderson, in Fig. 1 of discloses a method of reducing stiction in MEMS device comprising a moveable element 112 coupled to a substrate 104, the method comprising providing the substrate with an anti-stiction member 120a, 120b, and interposing the anti-stiction member between the movable member and the substrate.

The Applicants respectfully traverse the rejection. Claim 1 specifically recites that the substrate is provided with the anti-stiction members to reduce stiction in a MEMS device having a moveable element moveably coupled to a substrate and that an anti-stiction member is interposed between the moveable element and the substrate after the substrate has been provided with the anti-stiction member. By contrast, the elements 120a, 120b of Anderson that the Examiner identifies as anti-stiction members Anderson identifies as hard stops. Importantly, although Anderson does not explicitly say so, these hard stops 120a, 120b, are clearly shown in a fixed position and Anderson neither teaches nor suggests that any portion of these stops is moveable. Consequently, the stops cannot be interposed between the moveable element 112 and the substrate 104 after the substrate 104 has been provided with them. Consequently, Anderson does not recite all the features of claim 1. Similarly, because Anderson's hard stops 120a, 120b are fixed, they cannot possibly be interposable as that term is used in claims 15, 29 and 50 (see above). Being in a fixed position the hard stops 120a, 120b are not capable of being interposed. As such, claims independent claims 1, 15, 29 -16, 19-22, 24-30, 33-38, 40-45, 50-54 and 57-60 define an invention suitable for patent protection.

35 USC 103

Anderson in view of Lin

The Examiner has rejected claim 45 under 35 USC 103(a) as being unpatentable over Anderson in further view of U.S. Patent 6,215,921 to Lin (hereinafter Lin). In rejecting the claims, the Examiner applies Anderson as described above. The Examiner admits that Anderson does not disclose the moveable element as having translational movement. The Examiner states that Lin, in Fig. 7, discloses a moveable member having translational movement. The Examiner argues that it would have been obvious to one of skill in the art to use a moveable member with translation movement, so as to have effective displacement of the moveable member.

10 The Applicant respectfully traverses the rejection. Claim 45 depends from claim 29. For the reasons set forth above, Anderson does not teach all the limitations of claim 29. Furthermore, Fig 7 of Lin is devoid of any teaching or suggestion of translational movement. Instead, Fig. 7 depicts *pivotal* movement of a reflective panel 106 about a pivot axis "V" that extends through a hinge pin member 114 (see Fig. 7 and col. 6, lines 22-39). Therefore, no combination of Anderson with Lin teaches all the limitations of claim 45.

15 In addition, the Examiner has pointed to no specific teaching in either Anderson or Lin tending to support their combination. Therefore, the Examiner has not established a *prima facie* case of obviousness since obviousness cannot be established absent some teaching, suggestion or incentive supporting the combination (ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F. 2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)). Absent such a showing in the prior art, 20 the Examiner has impermissibly used the applicants teaching to hunt through the prior art for the claimed elements and combine them as claimed (see *In re Vaeck*, 947 F. 2d 488, 20 USPQ 2d 1438 (Fed. Cir. 1991); *In re Bond*, 910 F. 2d 831, 15 USPQ 2d 1566 (Fed. Cir. 1990); *In re Laskowski*, 871 F. 2d 115, 117, 10 USPQ 2d 1397, 1398 (Fed. Cir. 1989)). The use of hindsight is never permissible to establish obviousness.

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ALLOWABLE SUBJECT MATTER

The Examiner has allowed claims 46-49 and indicated that claims 2-10, 18-23, 25, 27, 28, 32-37, 39 and 56-61 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims and subject to 35 USC 112, second paragraph. The

Applicant appreciates the allowance of claims **46-49**. The Applicant believes, for the reasons set forth above, that claims **2-10, 18-23, 25, 27, 28, 32-37, 39** and **56-61** as they presently stand in the application are allowable over the prior art of record and that the Examiner's rejections under 35 USC 112, second paragraph have been addressed.

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CONCLUSION

For the reasons set forth above, the Applicants submit that all claims are allowable over the cited art and define an invention suitable for patent protection. The Applicants therefore respectfully request that the Examiner enter the amendment, reconsider the application, and issue a Notice of Allowance in the next Office Action.

10 Respectfully submitted,



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